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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,640	03/17/2004	Jarko Niemenmaa	59643.00402	1689

32294 7590 01/09/2006

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EXAMINER

DAGOSTA, STEPHEN M

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/801,640	<b>Applicant(s)</b> NIEMENMAA ET AL.	
	<b>Examiner</b> Stephen M. D'Agosta	<b>Art Unit</b> 2683	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-30 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A **timely filed terminal disclaimer** in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to **overcome** an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-30** provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 31-60 of copending Application No. 2005/0043038. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both describe using control and user planes in order to provide location determination data.

This is a **provisional** obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Drawings***

The drawings are objected to because figures 1-2 should provide labels/names for each component rather than a number. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-8 and 10-30** rejected under 35 U.S.C. 102(b) as being anticipated by Hayes US 6,225,944.

As per **claims 1, 15-16, 23, 25 and 28-29**, Hayes teaches a method in association with a communication system for providing location information (title, abstract), the method comprising:

signaling a request for a connection between user equipment and another party AND analyzing the requested connection; detecting whether location information is required in association with the requested connection AND activating a process for determining information about a location of the user equipment; (C1, L15 to C2, L20 teaches FCC-mandated E-911 which requires an emergency call to be analyzed, a user's location to be determined and location information to be transmitted to a PSAP.

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The examiner notes that the voice call will also transfer voice/data from/to and to/from the user/PSAP);

communicating first information in association with the determining process on a control plane between the user equipment and the communication system (C4, L3-20 teaches the MSC functionality being accomplished in a UMTS server and implemented in a control plane); and

communicating second information in association with the determining process on a user plane between the user equipment and the communication system (C4, L3-20 teaches the control plane being separate from the user plane and said user plane carrying voice channel communications. Hence "control messages" will be supported by the control plane while "voice communications" will be supported by the user plane. Furthermore, any call setup/management functions will be supported by the control plane while actual voice/data will flow through the user plane – which reads on the claim).

***With further regard to claim 15***, Hayes teaches a device/system (figures 1-2) which execute the algorithm/software shown in figure 3, which reads on "a computer program embodied on a computer readable medium, said medium comprising program code configured to execute at least one step of an analyzing method for providing location information in a communication system, when the program code is run on a computer".

***With further regard to claims 16, 23, 25 and 28***, Hayes teaches a communications system, a controller and connection means (see figure 1, which shows the system and connection means while figure 2 shows the processor/controller). A transceiver is also shown in figure 2, #114). For CLAIMS 25/28, a node/gateway can be interpreted as the MSC in figure 1, #140, a router/device in the network, #150 and/or the PSAP, #160.

***With further regard to claim 29***, Hayes teaches a device (figure 2) with processor, location means and transceiver. The processor determines if the dialed digits pertain to an E-911 call, whereby location services are supported via the GPS receiver onboard.

As per **claim 2**, Hayes teaches claim 1, wherein the step of communicating first information comprises requesting from the user equipment information about the location of the user equipment (C1, 33-38 teaches on-demand positioning from mobile, eg. after a request AND L54 to C2, L20 teaches the PSAP receiving the user's location).

As per **claim 3**, Hayes teaches claim 2, comprising the step of requesting supporting information by sending, in response to receiving said first information in the user equipment, second information from the user equipment to the communication system on the user plane (C4, L3-20 teaches the user plane supporting voice (or data), which reads on second information being sent via user plane. Also see C4, L43-57 teaches retransmission several times, etc.).

As per **claim 4**, Hayes teaches claim 1, wherein the step of detecting comprises detecting by the user equipment that location information is required in association with the requested connection (C1, L15 to C2, L20 teaches E-911 which requires user location information during an emergency call).

As per **claim 5**, Hayes teaches claim 4, wherein the step of detecting is followed by a step of requesting supporting information by sending the second information from the user equipment to the communication system on the user plane (C1, L15 to C2, L20 teaches E-911 which requires user location information during an emergency call AND C4, L3-20 which teaches sending voice/data over user plane).

As per **claim 6**, Hayes teaches claim 1, comprising further steps of sending to the user equipment a request for information supporting determination of location information on the control plane in response to detection that the location information is required in association with the requested connection (C1, L15 to C2, L20 teaches E-911 which requires location data to be sent while C4, L3-20 teaches control plane and user plane which support control messages and user voice/data. It is inherent to Hayes' system for control messages to be sent, eg. such as request messages. Hence a request would be supported via a control plane).

As per **claim 7**, Hayes teaches claim 1, wherein the step of analyzing comprises analyzing information associated with routing of the connection (figure 1, #150 shows a generic network and Hayes teaches that said network can be a TCP/IP network, see C4, L17-20. The examiner notes that TCP/IP networks inherently provide routing of data and thus Hayes' system, which uses this protocol, would then inherently support analyzing information associated with routing of the connection. Since IP requires identifying the sending and receiving endpoints, it "analyzes" where these points are located and then determines how best to route the packet thru the network).

As per **claim 8**, Hayes teaches claim 7, wherein the step of analyzing comprises verifying if a destination number of the connection satisfies a predefined condition (C1, L15 to C2, L20 teaches identifying if the call is a E-911 emergency call, which would be a predefined condition).

As per **claim 10**, Hayes teaches claim 1, wherein the step of communicating second information comprises communicating assistance data on the user plane (C1, L15 to C2, L20 teaches supporting sending of E-911 data between user and PSAP while C4, L3-20 teaches support for control/user planes. Hence any/all user data pertaining to the E-911 call would inherently be sent via the user plane).

As per **claim 11**, Hayes teaches claim 10, wherein the step of communicating second information further comprises communicating a request for assistance data on the user plane (C4, L3-20 teaches the user plane supporting voice/data traffic, hence one skilled understands that the location program will send/receive data via the user plane channel).

As per **claim 12**, Hayes teaches claim 1, wherein the step of detecting comprises detecting that the connection is for an emergency call (C1, L15 to C2, L20).

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As per **claim 13**, Hayes teaches claim 1, wherein the step of communicating second information comprises communicating Global Positioning System assistance data (C1, L38-65 teaches GPS and other positioning methods).

As per **claim 14**, Hayes teaches claim 1, comprising a further step of detecting that the user equipment supports a satellite based positioning system (C1, L54-65 teaches GPS positioning which is satellite-based).

As per **claim 17**, Hayes teaches claim 16, wherein the controller is provided in the user equipment (figure 2, processor #112).

As per **claim 18**, Hayes teaches claim 16, wherein the controller is provided in association with a location service entity connected to the communication system (figure 2 shows processor connected to GPS receiver and figure 1 shows device connecting to a PSAP).

As per **claim 19**, Hayes teaches claim 16, wherein said second information comprises supporting information for the location determining process (C1, L15 to C2, L20 teaches location data flowing between the user and PSAP).

As per **claim 20**, Hayes teaches claim 16, wherein the controller is configured to detect if the connection is for an emergency call (C1, L15 to C2, L20 teaches identifying an emergency call per E-911).

As per **claim 21**, Hayes teaches claim 16, comprising a first location service entity configured for control plane communications and a second location service entity configured for user plane communications (C4, L3-20 teaches control plane, which supports control messages while the user plane supports voice/data. Hence the control plane would support E-911 location control messages while the user plane would support the location voice/data).



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As per **claim 22**, Hayes teaches claim 16, comprising a location service entity configured for user and control plane communications (C4, L3-20 teaches support for control/user planes and Hayes teaches E-911 location services, hence the control/user planes would support location services).

As per **claim 24**, Hayes teaches claim 23, wherein the user equipment is configured to detect if location information is required in association with a connection (C1, L15 to C2, L20 teaches E-911 and location services).

As per **claim 26**, Hayes teaches claim 25, wherein the controller node comprises a location service server connected to the communication system (figure 1, PSAP).

As per **claim 27**, Hayes teaches claim 25, wherein the controller node comprises a gateway (the MSC provides a gateway to the network, #150 in figure 1).

As per **claim 30**, Hayes teaches claim 29, wherein the user equipment is configured to detect if location information is required in association with a connection (figure 3 and C1, L15 to C2, L20).

### ***Allowable Subject Matter***

**Claim 9** objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art, alone or in combination, does not disclose the “further steps of determining the location of the user equipment by the user equipment and communicating information about the determined location from the user equipment on the control plane”.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Bjelland et al. US 2002/0089949
2. Cervera et al. US 2003/0228872
3. Wang et al. US 2004/0242238
4. Niemenmaa et al. US 2005/0153706
5. Ruutu et al. US 2005/0197140

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bill Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stephen D'Agosta  
Primary Examiner

